



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,517	02/13/2004	Francis M. Claessens	46505/5	8907

1912 7590 12/20/2005

AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 PARK AVENUE
NEW YORK, NY 10016

EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,517

Applicant(s)

CLAESSENS ET AL.

Examiner

Allyson N. Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 3 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed September 29, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Maltseff (2002/0097282).

Maltseff teaches the following in regards to claims 3 and 8:

"A method for tracking tax payment information includes fixing a unique machine readable identifier to each of a number of taxable items, storing each of the unique machine readable identifiers in a computer readable memory, and storing tax payment information in the computer readable memory for each of the items. The unique machine readable identifier may take the form of a machine readable symbol such as a barcode symbol or as a wireless memory device such as a radio frequency identification ("RFID") tag. The tax information may include data such as the tax payment status, tax payment authority, a tax payment sum, a tax payment date, identify of a manufacturer, identify of a product or product type, and the identify of a product origin." (Abstract).

Art Unit: 2876

Additionally, Maltseff teaches placing the tag across the cover of the package such that the tax stamp must be destroyed when the package is opened, thereby preventing the package from being refilled. (paragraph 0002).

In regards to claim 8, Maltseff teaches fracturing the substrate thereby causing the RFID tag to become permanently disable. (paragraph 0032).

Allowable Subject Matter

4. Claims 4-6 are allowed.

The following is an Examiner's statement of reasons for allowance: The prior art of record, taken alone or in combination, fail to teach or fairly suggest the apparatus for use in tracking whether a tax has been paid for a closed container as is disclosed in claims 4-6 of the current invention. The claimed apparatus includes a very specific cap for the container and further includes either a second interconnection means or a ratcheting means. In particular prior art fails to specifically teach the cap for the container, wherein the cap has a cylindrical portion, a closed end of the cylindrical portion and an open end of the cylindrical portion, wherein the RFID tag is mounted on an inner surface of the cylindrical portion of the cap adjacent to the closed end such that a first connection means faces centrally inward. Prior art further fails to teach a second interconnection means connected to the container for engaging the first interconnection means when the cap is installed on the container such that removing the cap from the container will exert force on the substrate resulting in the fracture of the substrate and permanently disabling it. In a similar arrangement, prior art fails to teach a ratcheting means connected to the container for engaging the protrusion when

Art Unit: 2876

the cap is installed on the container such that removing the cap from the container will exert force on the substrate resulting in the fracture of the substrate and permanently disabling it. The combination of all of the limitations discussed above are not disclosed in prior art, and moreover, one of ordinary skill in the art would not be motivated to come up with the claimed invention.

Response to Arguments

5. Applicant's arguments regarding claims 3 and 8 have been fully considered but they are not persuasive. It is believed that Maltseff clearly teaches the simple cap for the container disclosed in claim 3. Additionally in regards to claims 3 and 8, as discussed above, Maltseff teaches permanently disabling the RFID tag when the cap of the bottle is removed. Clearly there must be an engagement member interconnecting the substrate and the container so that the removal of the cap results in this disabling.

Applicant's arguments with respect to claims 4-6 have been fully considered and are persuasive. Claims 4-6 are indicated above to be in condition for allowance.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

Art Unit: 2876

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

Art Unit: 2876

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
December 9, 2005



KARL D. FRECH
PRIMARY EXAMINER